REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicant respectfully submits that the pending claims comply with 35 U.S.C. § 101, comply with 35 U.S.C. § 112 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicant will now address each of the issues raised in the outstanding Office Action.

Objections

Claims 15-17, 27-29, 40-42, 59-61, 69-71 and 80-82 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Since, however, the independent claims are allowable for reasons set forth below, these claims have not been amended at this time.

Rejections under 35 U.S.C. § 101

Claims 7-10, 12-17, 19-22, 24-29, 32-35, 37-42 and 85 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter The applicant respectfully requests that the Examiner reconsider and

withdraw this ground of rejection in view of the following.

These method claims have been amended to recite that they are computer-implemented, with each of the acts being performed by a computer system including at least one computer. These amendments are supported, for example, by Figure 15 and section § 4.2.3 of the specification (which starts on page 24). Thus, the claims recite statutory subject matter for at least this first reason.

Further, the method claims transform accepted search query information into the transmission or controlled serving of items to a client device for rendering to a user. Thus, the claims recite statutory subject matter for at least this second reason.

Rejections under 35 U.S.C. § 112

Claims 7-10, 12-17, 19-22, 24-29, 32-35, 37-42, 53, 54, 56-61, 63, 64, 66-71, 74, 75, 77-81 and 85 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner contends that claims 7, 19, 32, 53, 63 and 74 recite the limitation of "automatically" generating a request, but the specification does not specifically teach this feature as claimed. The applicant respectfully disagrees.

The test of enablement is whether one of ordinary skill in the art could make or use the invention from the disclosures in the patent, coupled with information known

in the art, without undue experimentation. (See MPEP 2164.01.) In this instance, the act of generating, automatically (using a computer system), an item request including (i) a word included in the accepted search query, and (ii) one or more words determined to be related to the word included in the accepted search query is supported by elements 420, 422, 424 and 426 of Figure 4, page 16, lines 13-21, Figure 7 (which illustrates an exemplary data structure corresponding to information 426 of Figure 4), page 18, line 6 through page 19, line 2, Figure 11 (which illustrates an exemplary method corresponding to the operations 422 of Figure 4), page 20, lines 4-19, Figure 15 and page 24, line 10 through page 25, line 13. Using at least the cited sections of the application, one reasonably skilled in the art could make or use the claimed invention, coupled with information known in the art, without undue experimentation. Consequently, claims 7-10, 12-17, 19-22, 24-29, 32-35, 37-42, 53, 54, 56-61, 63, 64, 66-71, 74, 75, 77-81 and 85 comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. Thus, this ground of rejection should be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 7-10, 12, 13, 19-22, 24, 25, 32-35, 37, 38, 53, 54, 56, 57, 63, 64, 66, 67, 74, 75, 77, 78 and 85 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0078928 ("the Dorosario publication") in view of U.S. Patent No. 6,453,315 ("the Weissman patent"), U.S. Patent No. 6,907,566 ("the McElfresh patent") and U.S.

Patent Application Publication No. 2003/0182274 ("the Oh publication"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

As noted in the previous response and shown, in the example illustrated in Figure 16, embodiments consistent with the present invention may be used to search for items such as ads 1660 by accepting a query (e.g., iditarod 1620), finding related word(s) (e.g., alaska, dog sled, ... malamute 1634), and generating, automatically, a request including both the word in the original query, as well as the related word(s) (e.g., request 1640 including both iditarod and alaska, ... malamute).

Still referring to Figure 16, the items (e.g., ads) returned may be scored. The score of items returned in response to the related word(s) may be penalized relative to those returned in response to word(s) in the original query. For example, since ad A was returned in response to related word "alaska", its score is multiplied by a factor of 0.7 (1692). Since, on the other hand, ad B was returned in response to the word "iditarod" from the original query (1620), its score is not penalized (1694).

Independent claims 7, 19, 32, 53, 63 and 74 are not rendered obvious by the Dorosario publication, the Weismann patent, the McElfresh patent and the Oh publication at least because:

(1) these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) ***automatically*** generating an ad

request including both (i) a word included in an accepted search query, and (ii) one or more words determined to be related to the word included in the accepted search query;

(2) these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) adjusting the scores of any items retrieved on the basis of the one or more words determined to be related to the word included in the accepted search query relative to any items retrieved on the basis of the word included in the accepted search query, or an act of (or means for) determining a score for each of a number of retrieved items, wherein a score component is adjusted for any items retrieved on the basis of the one or more words determined to be related to the word included in the accepted search query; and

(3) one skilled in the art would not have combined these references, and then further modify this combination, as proposed by the Examiner.

Each of these three issues is addressed below.

First, independent claims 7, 19, 32, 53, 63 and 74 are not rendered obvious by the Dorosario publication, the Weismann patent, the McElfresh patent and the Oh publication because these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) ***automatically*** generating an ad request including both (i) a word included in an accepted search

query (recall, e.g., "iditarod" in Figure 16), and (ii) one or more words determined to be related to the word included in the accepted search query (recall, e.g., "alaska", "dog sled", ..., "malamute" in Figure 16.).

The Examiner cites paragraphs [0036] and [0041]-[0043] of the Dorosario publication as teaching generating an ad request including both (i) a word included in an accepted search query, and (ii) one or more words determined to be related to the word included in the accepted search query. (See Paper No. 20080528, page 4.) Cited paragraph [0036] of the Dorosario publication illustrates how to resolve an ambiguous query word, such as "Saturn" which might pertain to the planet, the car, or the video game. The Dorosario publication discusses presenting suggestions to a user, and ***modifying (effectively narrowing) the search according to the selection made by the user***. Thus, although the cited section of Dorosario publication concerns modifying a search query with supplemental search terms, ***it does not do so automatically, but rather requires manual user selection.***

The Examiner concedes that the Dorosario publication does not teach automatically generating the request (See Paper No. 20080528, page 4.), but relies on the Oh publication as teaching "automatic tasking in a search engine with advertising functionality" (Paper No. 20080528, page 5), citing the Abstract and paragraph [0051]. Frankly, the applicant cannot see how the cited portions of the Oh publication teach the features alleged. More specifically, the Abstract of the Oh publication introduces "[a] navigable search engine architecture comprising a plurality of search look up

tables (10) having predetermined search values ***selectable by a user to define a search criteria***. . . . [Emphasis added.]" and notes that " ***[w]hen a user has defined a search criteria*** using said search values, the search engine finds and lists (20) the headings of the nodes that are related to said search criteria. [Emphasis added.]" This does not teach, suggest, or make obvious ***automating the act of modifying (effectively narrowing) a search according a manual the selection made by the user*** in the Dorosario publication. Indeed, doing so would destroy the ability of the Dorosario publication to capture the defined (and clarified) intent of the user. Paragraph [0051] of the Oh publication states:

> Thus, in the above example, ***if the user has selected "Los Angeles" for search value 12a, "Sydney" for search value 12b and "flights" for search value 12c, the search engine automatically detects that there are two banner ads listed in its target directory 14d***, namely a banner ad for Qantas Airways and a banner ad for American Airlines, both of which offer flights between Los Angeles and Sydney. Both Qantas Airways and American Airlines have paid to have their advertisements appear on screen when these search values are nominated. The duration and manner in which each banner ad is displayed will be a function of the basis on which advertising space is sold. It will be seen that this feature of the preferred search engine provides a significant advantage over prior art search engines as particular vendors' advertising can be targeted to selected end users, rather than simply displayed at random

> as in prior art search engines.
> [Emphasis added.]

Likewise, this does not teach, suggest, or make obvious ***automating the act of modifying (effectively narrowing) a search according a manual the selection made by the user*** in the Dorosario publication.

As can be appreciated from the foregoing, one skilled in the art would not have been combined the purported teachings Dorosario publication and the Oh publication, and even if one did, any automation taught by the Oh publication is in a context different from ***modifying (effectively narrowing) a search according a manual the selection made by the user*** in the Dorosario publication.

Paragraphs [0041]-[0043] of the Dorosario publication, cited by the Examiner, discuss associating words or phrases (e.g., chunks) of a user query with advertisement categories. As an example, "german sheppard" may be associated with the category "dogs". These categories then populate a user's preferred ad preference file, which is a list of predefined ad categories to which the user's past queries (or portions thereof) belong. These categories, but apparently ***not the original search query terms***, are used to target ads. Thus, even if these categories (e.g., "dog") can be characterized as words related to words of the search query (e.g., "german sheppard"), the Dorosario publication apparently only uses the category, but apparently ***does not use the original search query, to retrieve ads***. For example, the Dorosario publication states:

> advertisement targeting process 34 allows for the creation and maintenance of an ***advertisement preference files 48 for each user*** 10 entering a query 40 into search engine 20. These advertisement preference files specify the areas of interest for that particular user. Accordingly, by understanding the areas in which a particular user is interested, ***area-specific advertising can be targeted*** and transmitted ***to that user***. Advertisement targeting process 34 includes a file repository process 80 for storing ***advertisements grouped in accordance with predefined advertisement categories*** 44. Thus, if user 10 runs a considerable number of searches (i.e. executes queries) relating to automobiles, they are most-likely a car enthusiast. Therefore, advertisement preference file 48 would specify an area of interest for user 10 as being ***automobiles***. Therefore, user 10 would probably be interested is seeing ads relating to various automobiles and automobile related products (e.g., automotive accessories, high performance driving schools, etc.).
>
> An advertisement transmission process 82 processes the advertisement preference file 48 for user 10, ***retrieves the appropriate category-specific advertisements from advertisement repository*** 80 and transmits these advertisements to user 10 so they can be viewed/heard on user's computer 38. [Emphasis added.]

Paragraphs [0065] and [0066].

As can be appreciated from the foregoing, the cited portions of the Dorosario publication do not teach an act

of, or means for, automatically generating an ad request (a user selection is required in paragraph [0036] of the Dorosario publication) including ***both*** (i) ***a word included in an accepted search query***, ***and*** (ii) one or more words determined to be related to the word included in the accepted search query (apparently, only the category, not the original query terms, is used to retrieve ads in the Dorosario publication). Furthermore, none of the purported teachings of the Weismann patent, the McElfresh patent and the Oh publication compensate for this deficiency.

Thus, independent claims 7, 19, 32, 53, 63 and 74 are not rendered obvious by the Dorosario publication, the Weismann patent, the McElfresh patent and the Oh publication for at least this first reason. Since claims 8-10, 12, 13 and 85 directly or indirectly depend from claim 7, since claims 20-22, 24 and 25 directly or indirectly depend from claim 19, since claims 33-35, 37 and 38 directly or indirectly depend from claim 32, since claims 54, 56, 57 and 62 directly or indirectly depend from claim 53, since claims 64, 66 and 67 directly or indirectly depend from claim 63 and since claims 75, 77 and 78 directly or indirectly depend from claim 74, these claims are similarly not rendered obvious by the cited references.

Second, independent claims 7, 19, 53, and 63 are not rendered obvious by the Dorosario publication, the Weismann patent, the McElfresh patent and the Oh publication because these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) ***adjusting the scores of any items***

retrieved on the basis of the one or more words determined to be related to the word included in the accepted search query (e.g., a score of ad A, retrieved due to "alaska", is multiplied by 0.7 in Figure 16) ***relative to any items retrieved on the basis of the word included in the accepted search query*** (e.g., the score of ad B, which is retrieved due to "iditarod", is not adjusted in Figure 16). Similarly, independent claims 32 and 74 are not rendered obvious by the Dorosario publication, the Weismann patent, and the McElfresh patent because these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) ***determining a score for each of a number of retrieved items, wherein a score component is adjusted for any items retrieved on the basis of the one or more words determined to be related to the word included in the accepted search query*** (e.g., a score of ad A, retrieved due to "alaska", is determined using adjustment factor 0.7 in Figure 16) ***relative to any items retrieved on the basis of the word included in the accepted search query*** (e.g., the score of ad B, which is retrieved due to "iditarod", is not adjusted in Figure 16). Note that some embodiments consistent with the present invention adjust a previously determined score (See, e.g., 690 of Figure 6.), while in other embodiments consistent with the present invention, the score is effectively adjusted during its determination. (See, e.g., 535 and 550 of Figure 5.)

The Examiner cites paragraph [0044] of the Dorosario publication as teaching these feature. (See Paper No. 20080528, page 4.) However, this section of the Dorosario publication concerns automatic categorization

methods for categorizing previously uncharacterized words into categories. Thus, predefined advertisement categories can change and evolve. As one example, the category "baseball" might initially include the names of all present major league baseball teams. However, this category might evolve to later include the names of expansion teams. Although not mentioned in the cited section, the categorization of a word or phrase may change over time. For example, the term "titantic" might be initially categorized under "history", but might later be categorized under "entertainment". (See, e.g., paragraph [0054] of the Dorosario publication.)

In any event, neither the automated categorization techniques, nor the fact that words may be recategorized, teach adjusting a score, or influencing the scoring, of items retrieved on the basis of an item request including a word included in an accepted search query and one or more words determined to be related to the word included in the accepted search query such that any items retrieved on the basis of the one or more words determined to be related to the word included in the accepted search query are treated differently than any items retrieved on the basis of the word included in the accepted search query.

The Examiner also seems to imply that the Weissman patent teaches score adjustment based on ad performance. (See Paper No. 20080528, pages 4 and 5.) However, simply adjusting a score ***based on ad performance***, does not teach, nor does it make obvious, ***adjusting the scores of any items retrieved on the basis of the one or more words determined to be related to the word included in the accepted search query relative to any items retrieved on***

the basis of the word included in the accepted search query. The former concerns an attribute of an advertisement, while the latter concerns components of an item request used to retrieve an item.

Thus, independent claims 7, 19, 32, 53, 63 and 74, as amended, are not rendered obvious by the Dorosario publication, the Weismann patent, the McElfresh patent and the Oh publication for at least this second reason. Since claims 8-10, 12, 13 and 85 directly or indirectly depend from claim 7, since claims 20-22, 24 and 25 directly or indirectly depend from claim 19, since claims 33-35, 37 and 38 directly or indirectly depend from claim 32, since claims 54, 56, and 57 directly or indirectly depend from claim 53, since claims 64, 66 and 67 directly or indirectly depend from claim 63 and since claims 75, 77 and 78 directly or indirectly depend from claim 74, these claims are similarly not rendered obvious by the cited references.

Third, one skilled in the art would not have combined these references, and then further modify the combination, as proposed by the Examiner. The Examiner contends:

> it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Dorosario et al., Weissman et al., McElfresh et al. and Oh with the adjusting being solely based on the one or more words determined to be related to the word included in the accepted search query relative to any items retrieved on the basis of the word included in the

> accepted search query ***since it was known in the art that different schemes of advertising utilizing an assortment of features are used to provide a specific scope in the targeted audience sought by the advertiser such as the criteria included in broadening and/or restricting the reach of the targeted advertisement in view of the search results. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.*** [Emphasis added.]

(Paper No. 20071119, pages 5 and 6.) The applicant respectfully disagrees.

The Examiner's general assertion is insufficient, as a matter of law, to support a conclusion that one skilled in the art would have combined the references, and then further modified the combination as proposed by the Examiner. Alleging that it was known in the art that ***different schemes of advertising utilizing an assortment of features are used to provide a specific scope in the targeted audience sought by the advertiser***, is merely a general allegation that there were various techniques known for advertisers to target their ads. Regardless of whether or not there are "different schemes" using "an assortment of features", such a general allegation cannot support rejecting the specific methods and apparatus claimed. If such a relaxed standard were to be applied, ***any*** specific technique of targeting advertisements (or of retrieving, scoring and service items) would be rendered obvious, which is clearly improper.

Consequently, independent claims 7, 19, 32, 53, 63 and 74 are not rendered obvious for at least this

additional reason. Since claims 8-10, 12, 13 and 85 directly or indirectly depend from claim 7, since claims 20-22, 24 and 25 directly or indirectly depend from claim 19, since claims 33-35, 37 and 38 directly or indirectly depend from claim 32, since claims 54, 56, 57 and 62 directly or indirectly depend from claim 53, since claims 64, 66 and 67 directly or indirectly depend from claim 63 and since claims 75, 77 and 78 directly or indirectly depend from claim 74, these claims are similarly not rendered obvious by the cited references.

Claims 14, 26, 39, 58, 68 and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Dorosario and Oh publications and the Weissman and McElfresh patents and further in view of U.S. Patent Application Publication No. 2002/0059094 ("the Hosea publication"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The purported teachings of the Hosea publication would not compensate for the deficiencies of the Dorosario publication, the Weissman patent, the McElfresh patent and the Oh publication with respect to claims 7, 19, 32, 53, 63 and 74, discussed above, regardless of the scope of the purported teachings of the Hosea publication, and regardless of the presence or absence of an obvious reason to combine these references. Thus, these claims are not rendered obvious by the Dorosario publication, the Weissman patent, the McElfresh patent, the Oh publication and Hosea publication for at least this reason.

Conclusion

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Examiner pass this application to issue.

Any arguments made in this amendment pertain ***only*** to the specific aspects of the invention ***claimed***. Any claim amendments or cancellations, and any arguments, are made ***without prejudice to, or disclaimer of***, the applicant's right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicant's remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicant's silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicant that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicant reserves the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

December 15, 2008

John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 936-1400

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